

07-16-01

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Patent  
Attorney Docket: 265/247

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No.: 265/247  
First Named Inventor: Jing Cheng et al.  
Prior Application Information:  
Serial No. 09/548,522  
Examiner: J. Starsiak  
Art Unit: 1743

Commissioner for Patents  
Box Patent Application  
Washington, D. C. 20231

## FILING UNDER 37 CFR § 1.53(b)

This is a request for filing for a

☒ continuation ☐ divisional ☐ continuation-in-part (CIP)

application under 37 CFR § 1.53(b) of pending prior application Serial No. 09/548,522 filed on April 13, 2000, which will issue as U.S. Patent No. USPatentNo on IssueDate, by

**Jing Cheng et al., entitled:**

## CHANNEL-LESS SEPARATION OF BIOPARTICLES ON A BIOELECTRONIC CHIP BY DIELECTROPHORESIS

**For CONTINUATION or DIVISION APPS only:** The entire disclosure of the prior application, from which an oath or declaration is supplied, referenced above, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

### I. APPLICATION ELEMENTS ENCLOSED

29 Page(s) of Written Description  
5 Page(s) of Claims  
1 Page(s) of Abstract  
15 Sheet(s) of Drawings ☒ formal ☐ informal  
2 Page(s) of ☒ Declaration or ☐ Declaration and Power of Attorney  
☒ Copy from prior application [37 CFR §1.63(d)]  
☐ Newly executed  
\_\_\_\_ Other:

OC-86157.1

### CERTIFICATE OF MAILING (37 C.F.R. §1.10)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as 'Express Mail Post Office To Addressee' in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

EL496950924US  
Express Mail Label No.

July 13, 2001  
Date of Deposit

Adriana Mojarro

Name of Person Mailing Paper

Signature of Person Mailing Paper

11000 U.S. PRO  
09/905755  
07/13/01

11131 U.S. PRO  
07/13/01

09906755 "071301"

- ☒ Assignment papers (cover sheet and documents(s))  
☒ An Information Disclosure Statement, PTO 1449, ☐ with copies of cited items.  
☐ Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i). Applicant must attach form PTO/SB/35

## II. FEE CALCULATION

- ☒ Applicant claims small entity status under 37 CFR 1.27.

<b>BASIC FILING FEE:</b>						\$710.00
Total Claims	20	-	20	=	0	x \$18.00 \$0.00
Independent Claims	3	-	3	=	0	x \$80.00 \$0.00
Multiple Dependent Claims	\$270	(if applicable)				<input type="checkbox"/> \$0.00
<b>TOTAL OF ABOVE CALCULATIONS</b>						\$710.00
Reduction by ½ for Filing by Small Entity.						<input checked="" type="checkbox"/> \$355.00
Misc. Filing Fees (Recordation of Assignment)						\$0.00
<b>TOTAL FEES DUE HERewith</b>						\$355.00

## III. PRIORITY - 35 USC § 119

- ☐ Priority of application Serial No. \_\_\_\_\_ filed on \_\_\_\_\_ in Country is claimed under 35 USC § 119.  
☐ The certified copy has been filed in prior U.S. application Serial No. \_\_\_\_\_ on \_\_\_\_\_.  
☐ The certified copy will follow.

## IV. AMENDMENTS

- ☐ Cancel in this application original Claims \_\_\_\_\_ of the prior application before calculating the filing fee. (At least one original independent claim must be retained for filing purposes if no new claims are added in a preliminary amendment.)  
☐ A Preliminary Amendment is enclosed. (Claims added by Amendment must be numbered consecutively beginning with the number next following the highest numbered original claim in the prior application.)

**V. RELATE BACK - 35 USC § 120**

- ☐ Relate back information included in preliminary amendment or specification.  
☒ Please amend the specification as follows:

This application is a continuation of copending U.S. Application No. 09/548,522, filed on April 13, 2000, which is a continuation of U.S. Application No. 09/016,596, filed on January 30, 1998, Patent No. 6,071,394, which is a continuation-in-part of U.S. Application No. 08/709,358, filed on September 6, 1996, Patent No. 6,129,828.

- ☒ With respect to the prior co-pending U.S. application from which this application claims benefit under 35 USC § 120, the inventor(s) in this application is (are) [37 CFR 1.53(b)(1)]:
- ☒ the same.
- ☐ less than those named in the prior application and it is requested that the following inventor(s) identified above for the prior application be deleted [see 37 CFR §§1.33(b) AND 1.63(d)(2)]:
- [Name(s) of inventor(s) to be deleted]

**VI. METHOD OF PAYMENT OF FEES**

- ☒ Attached is a check in the amount of \$355.00.
- ☐ Charge Lyon & Lyon's Deposit Account No. **12-2475** in the amount of \_\_\_\_.
- ☐ Not attached. No filing fee is submitted. [This and the surcharge required by 37 CFR § 1.16(e) can be paid subsequently.]

**VII. AUTHORIZATION TO CHARGE ADDITIONAL FEES**

The Commissioner is hereby authorized to credit Lyon & Lyon's Deposit Account No. **12-2475** for any over payment of fees and to charge the following additional fees by this paper and during the entire pendency of this application to Deposit Account No. **12-2475**:

- ☒ 37 CFR § 1.16 (Filing fees and excess claims fees)
- ☒ 37 CFR § 1.17 (Application processing fees)
- ☐ 37 CFR § 1.21 (Assignment recordation fees)

**VIII. POWER OF ATTORNEY & CORRESPONDENCE ADDRESS**

- ☒ The power appears in the original papers in the prior application.
- ☐ The power does not appear in the original papers, but was filed on \_\_\_\_ in prior application Serial No. \_\_\_\_.
- ☐ A new power has been executed and is attached.

Please send all correspondence to Customer Number 22249:



**22249**  
PATENT TRADEMARK OFFICE

LYON & LYON LLP  
Suite 4700  
633 W. Fifth Street  
Los Angeles, CA 90071  
(213) 489-1600

Please direct all inquiries to Polaphat Veravanich, at the above Customer Number.

**IX. MAINTENANCE OF CO-PENDENCY OF PRIOR APPLICATION**

- ☐ A petition, fee and response has been filed to extend the term in the pending **prior** application until \_\_\_\_\_. A copy of the petition for extension of time in the **prior** application is attached.
- ☐ A conditional petition for extension of time is being filed in the pending **prior** application. A copy of the conditional petition for extension of time in the **prior** application is attached.


**X. ABANDONMENT OF PRIOR APPLICATION**

- ☐ Please abandon the prior application at a time while the prior application is pending or when the petition for extension of time or to revive in that application is granted and when this application is granted a filing date so as to make this application co-pending with said prior application. At the same time, please add the words "now abandoned" to the amendment of the specification set forth in Item V above.

Respectfully submitted,

LYON & LYON LLP

Dated: July 13, 2001

By:   
Polaphat Veravanich  
Reg. No. 45,179

Enclosures

Nanogen, Inc.  
Name of Assignee

10398 Pacific Center Court, San Diego, California 92121  
Address of Assignee

Vice President and General Counsel  
Title of person authorized to sign on behalf of assignee

Assignment recorded in PTO on June 8, 1998, Reel 9262, Frame 0628